

Application No. 09/857,257  
Reply to Office Action of September 6, 2006

### REMARKS

Presently, claims 1-9 and 47-80 are pending in the application. Claims 1, 5, 52, 59, 63, and 71 have been amended to correct formal matters. Claim 77 has been canceled. Accordingly, no new matter has been added by the foregoing amendments.

### *Claim Rejection – § 112*

The Examiner has rejected claims 48, 49, 55, 56, 67, 68, and 77 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner argues that the terms “non-Boolean” and “gradation” are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant respectfully traverses this rejection.

With respect to the phrase “non-Boolean”, Applicant respectfully directs the Examiner’s attention to page 18, line 17-18 of the specification, for example. The specification discusses increasing bids based on the “degree of correlation of the advertisement with the consumer.” Those skilled in the art would recognize that a variable that provides a “degree” of something is therefore able to provide a continuum of indications or representations with respect to what that variable represents. Those skilled in the art would further recognize that a Boolean variable is one that is capable of providing only a binary indication (e.g., true or false, on or off, yes or a no, or “0” or “1”). Thus, one skilled in the art would recognize that a variable conveying measurement of some “degree”, as described in the specification, would naturally be non-Boolean. Accordingly, one skilled in the art would understand that the term non-Boolean as recited in the claims is supported by the specification.

The Examiner seems to contend that simply because a variable can be equal to 0 or 1, even if it could have values greater than 1 (or values between 0 and 1), that such a variable would be considered to be Boolean. This is incorrect: a Boolean variable can

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only have the values 0 or 1; by definition, a Boolean variable cannot have any other values. Therefore, a variable that is described as being capable of having values that exceed 1, or having values between zero and 1, is clearly non-Boolean.

The term "gradation" is synonymous with the term degree. Therefore, one skilled in the art would recognize that a variable defined as representing a degree, could also be said to convey a gradation. Applicant therefore submits that the specification provides adequate support for the concept of "non-Boolean" and "gradation" as recited in the claims, and that such terms are described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Although Applicant does not agree with the Examiner's contention that simultaneous transmission is not enabled, to further prosecution of the present application, claim 77 has been canceled. Applicant respectfully requests that the Examiner reconsider and withdraw the 35 U.S.C. §112, first paragraph rejection of claims 48, 49, 55, 56, 67, 68, and 77.

#### *Claim Rejection – § 103(a)*

The Examiner has rejected claims 1-8 and 47-80 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,253,189 to Feezell et al. ("Feezell") in view of U.S. Patent No. 6,327,574 to Kramer et al. ("Kramer"). Applicant respectfully traverses this rejection.

Feezell teaches a system for completing advertising time slot transactions. The seller of a time slot identifies the slot and provides marketing and evaluation data for that time slot to assist the buyer in determining which slots to bid for. The buyer may submit a bid for a specific time slot or enter a "non-specific bid". A non-specific bid is based upon criteria not specific to a particular time slot, such as a bid that specifies a time slot with a particular viewer demographic. Feezell's system identifies whether a bid matches

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an available time slot. The buyer may be informed of multiple slots that match the bid and be allowed to choose which ad to purchase. If the offer terms match a time slot, then that time slot may be automatically assigned to the buyer.

Kramer characterizes consumers and products on the basis of certain behavioral attributes, formal mathematical constructs, or other characteristics. The characteristic values are represented as vectors of real numbers. A vector related to a consumer represents his interests and a vector related to a product represents the appeal of the product. Kramer teaches that the greater correlation between a consumer profile and a product profile at a given time, the greater the expected appeal of the product to that consumer.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. See MPEP 2143. Applicant submits that there is no motivation to combine the references and the combination, even if proper, does not teach all aspects of independent claim 1.

The Examiner has failed to point to a convincing motivation that would lead one skilled in art to combine Feezell and Kramer and has therefore failed to establish a *prima facie* case of obviousness. The Examiner argues that "One would have been motivated to use a correlation factor in Feezell et al.; thus, allowing a more efficient matching of advertisement and the consumer in the bidding process." Even if a correlation factor could be combined into Feezell it would not lead to matching of advertisements with consumers because Feezell does not match advertisements and consumers as the Examiner claims. Instead, Feezell matches "non-specific" bids with time slots. One skilled in the art implementing the system of Feezell which matches time slots to non-specific bids would not look to a system which matches specific consumer profiles with product profiles.

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Furthermore, the proposed modification would change the principle of operation of the primary reference. As the Examiner is well aware, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); MPEP § 2143.01. The systems of Feezel and Kramer are incompatible and not interchangeable because they work on different paradigms, with Feezell matching "non-specific" bids with time slots, while Kramer teaches matching consumers to content. In other words, Feezell provides "a method for completing advertising time slot transactions," (abstract) whereas Kramer provides for "selecting the variable content alternatives encoded in the structured documents that most closely match the consumer's profile" (abstract). Therefore, there is no motivation to modify the system of Feezell with the teachings of Kramer.

Even if the combination is proper, all aspects of independent claim 1 are not taught by the proposed combination of Feezell and Kramer.

Independent claim 1 recites

In a networked environment having a plurality of computer systems interconnected for the purpose of transmitting and receiving data, a method for auctioning an advertisement opportunity, said method comprising:

(a) providing notification of an advertisement opportunity from a content/opportunity provider computer system, wherein said advertisement opportunity corresponds to an opportunity to transmit an advertisement to a consumer;

(b) receiving an advertisement characterization from an advertiser computer system, wherein said

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advertisement characterization corresponds to an advertisement;

(c) calculating a correlation factor between said advertisement characterization and said consumer in a profiler computer system;

(d) transmitting said correlation factor to said advertiser computer system prior to receiving a bid for said advertisement opportunity from said advertiser computer system; and

(e) receiving a successful bid for said advertisement opportunity at said content/opportunity provider computer system, wherein said successful bid results in the transmission of said advertisement to said consumer in said advertisement opportunity.

The Examiner argues that Feezell teaches the concept of an "opportunity to transmit an advertisement to a consumer." Feezell does not teach or suggest such a concept. Rather, Feezell only teaches an ad slot that is not specific to a consumer, but only to a viewer demographic describing likely viewers. In other words, in Feezell, the advertisement presented in the ad slot will not necessarily reach "a consumer;" the advertiser is only obtaining the right to place an ad in a particular slot. Furthermore, even if the advertisement does reach a consumer, there is no assurance as to what characteristics the consumer will have. The only assurance is that the ad slot in question has likely viewers fitting certain demographics.

The Examiner argues that Feezell teaches calculating a correlation factor between the advertisement characterization and the consumer (although admitting that Feezell does not teach a correlation factor). Again, Feezell does not teach calculating anything in

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relation to a consumer, but only determines whether a non-specific bid matches the demographics of an advertisement slot (i.e., "a buyer can bid for a time slot that occurs in a program to be shown in the greater Chicago metropolitan area in a range of dates in late June and to viewers who fit a particular demographic profile" (column 10, lines 7-10)). However, whether actual viewers will fit that demographic profile is unknown and it is only a "viewership estimate" based on historical data. The Examiner seems to incorrectly read Feezell as teaching matching a consumer with an ad characterization, whereas Feezell actually only teaches comparing an ad slot (having associated demographic information) with a non-specific bid.

Therefore, even if the correlation factor that the Examiner argues is taught by Kramer is substituted into the system of Feezell, the combination would not teach all aspects of claim 1. This is because Feezell teaches matching a non-specific bid with an ad slot having a demographic. Therefore, modifying Feezell with a correlation factor would result in the calculation of the correlation between the non-specific bid and the ad slot. This does not teach all aspects of the present invention at least because an ad slot (with associated demographic information) is not the same as a consumer. An ad slot is an available slot to display an ad with likely viewership information and there is not guarantee that the ad will be presented to any consumer, let alone one with characteristics correlated to an advertisement.

Furthermore, the proposed combination of Feezell and Kramer does not teach "providing notification of an advertisement opportunity...an opportunity to transmit an advertisement to a consumer." Feezell offers the opportunity to purchase a time slot, but not "an opportunity to transmit an advertisement to a consumer." The time slot in Feezell may have related demographic information available, but is not specific to a consumer. Kramer does not have any disclosure concerning providing notification of advertisement opportunities. Therefore, the combination of Feezell and Kramer do not teach or suggest "providing notification of an advertisement opportunity...an opportunity to transmit an advertisement to a consumer."

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Additionally, the proposed combination of Feezell and Kramer does not teach or suggest "transmitting said correlation factor to said advertiser computer system prior to receiving a bid for said advertisement opportunity from said advertiser computer system." Neither Feezell nor Kramer suggests transmitting a correlation factor to the advertisement computer system prior to receiving a bid. Feezell teaches that a buyer may submit a bid for a non-specific time slot specifying certain demographic characteristics of the predicted audience the buyer desires to reach. Bids in Feezell are submitted without (and before) receiving a correlation factor calculated between a consumer and an advertisement. Feezell does teach that information may be provided to the buyer concerning a time slot. However this information does not include a correlation factor, much less a correlation factor between an advertisement characterization and a consumer. Rather, this information includes "time slot offers, marketing and valuation data, historical transactions, and other data..." None of the data that is provided by Feezell is a correlation factor between a consumer and an advertisement characterization. The information is just a generalized summary of the ad slot. Furthermore, this information could not contain a correlation factor between a consumer and an ad characterization because, at the time the buyer receives this information, the buyer has not yet submitted any information, which could be used to calculate a correlation factor. Only when the buyer bids does he submit information according to Feezell. Thus, in Feezell, no correlation can be returned until after the bid. Although, Feezell's system does determine whether the offer terms match the bid terms of a buyer, the result of this matching is not communicated to the buyer. Feezell simply teaches that time slots are matched according to the bid terms.

Kramer also does not teach that a correlation factor is transmitted prior to receiving a bid. Kramer is not concerned with a bidding process. Rather, Kramer is concerned with presenting the most highly correlated content. Thus, neither of the references individually, nor in combination, teaches nor suggests providing the buyer with a correlation factor between an ad characterization and a consumer. Therefore, the combination of Feezell and Kramer do not teach or suggest "transmitting said correlation

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factor to said advertiser computer system prior to receiving a bid for said advertisement opportunity from said advertiser computer system.”

Since there is no motivation to combine Feezell and Kramer and, even if the combination is proper, it does not teach all aspects of independent claim 1, independent claim 1 is believed to be patentable over the proposed combination of Feezell and Kramer.

With respect to independent claim 52, since the Examiner only makes reference to Feezell, the Examiner seemingly argues that claim 52 is rendered obvious entirely by Feezell. Applicant assumes that the Examiner intended to cite both Feezell and Kramer. Independent claim 52 recites “providing notification of an advertisement opportunity...an opportunity to transmit an advertisement to a consumer,” and that a “successful bid is received in response to said correlation factor being transmitted.” As discussed above, there is no motivation to combine Feezell and Kramer, and even if the proposed combination of Feezell and Kramer is proper, such combination does not teach or suggest recites “providing notification of an advertisement opportunity...an opportunity to transmit an advertisement to a consumer.” Additionally, the proposed combination does not teach or suggest that a “successful bid is received in response to said correlation factor being transmitted.” In Feezell, a bid is submitted before the offer terms of the bid are compared to the offer terms of the seller. Furthermore, as discussed above, valuation data is not a correlation factor nor does Kramer (alone or in combination with Feezell) teach or suggest receiving a bid “in response to said correlation factor being transmitted.” Thus, independent claim 52 is believed to be patentable over the proposed combination because there is no motivation to combine Feezell and Kramer and even if the combination is proper, it does not teach all aspects of independent claim 52.

The Examiner has failed explain how the combination of Feezell and Kramer teaches all aspects of dependent claim 57. Applicant submits that claim 57 is patentable for at least the same reasons as independent claim 52. Furthermore, the Examiner argues that the proposed combination of Feezell and Kramer “do not explicitly disclose wherein the value of said successful bid is dependent on the correlation factor transmitted in step



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(d),” and that Feezell “discloses the successful bid is based on the valuation data,” (Office Action, page 15). The Examiner does not explain how valuation data is equivalent to a correlation factor or how the bid in Feezell depends on the valuation data. Feezell does not describe what valuation data is, however valuation data is not equivalent to a correlation factor. It is clear from Feezell that valuation data is not a correlation factor because at the time the valuation data is provided to the buyer, the buyer has submitted no information that could be correlated or even compared. Thus, claim 57 is believed to be patentable over the proposed combination because there is no motivation to combine Feezell and Kramer and even if the combination is proper, it does not teach all aspects of claim 57.

With respect to independent claim 63, the Examiner again seemingly argues that independent claim 63 is rendered obvious entirely by Feezell. Applicant assumes that the Examiner intended to cite both Feezell and Kramer in respect to independent claim 63. Independent claim 63 recites “providing notification of an advertisement opportunity...an opportunity to transmit an advertisement to a consumer,” and “wherein said bid is based on said correlation factor.” As discussed above, the proposed combination of Feezell and Kramer does not teach or suggest recites “providing notification of an advertisement opportunity...an opportunity to transmit an advertisement to a consumer.” Additionally, the proposed combination does not teach or suggest that “said bid is based on said correlation factor.” In Feezell, a bid is submitted before the offer terms of the bid are compared to the offer terms of the seller and therefore could not be based on the correlation factor. Furthermore, as discussed above, valuation data is not a correlation factor nor does Kramer (alone or in combination with Feezell) teach or suggest receiving a bid “wherein said bid is based on said correlation factor.” Thus, independent claim 63 is believed to be patentable over the proposed combination because there is no motivation to combine Feezell and Kramer and even if the combination is proper, it does not teach all aspects of independent claim 63.

The Examiner has seemingly argued that independent claim 71 is rendered obvious by Feezell alone. Applicant assumes that the Examiner intended to cite both Feezell and Kramer. Independent claim 71 recites “receiving at an advertiser computer

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system notification of an advertisement opportunity, from a content/opportunity provider computer system, wherein said advertisement opportunity corresponds to an opportunity to transmit an advertisement to a consumer." As discussed above in relation to claim 1, the proposed combination of Feezell and Kramer does not teach or suggest recites receiving at an advertiser computer system notification of an advertisement opportunity, from a content/opportunity provider computer system, wherein said advertisement opportunity corresponds to an opportunity to transmit an advertisement to a consumer." Thus, independent claim 71 is believed to be patentable over the proposed combination because there is no motivation to combine Feezell and Kramer and even if the combination is proper, it does not teach all aspects of independent claim 71.

Dependent claims 2-4, 6-8, 47-51, 53-58, 60-62, 64-70, and 72-80 are allowable at least by dependency on independent claims 1, 5, 52, 59, 63, and 71, respectively. Claim 77 has been canceled. Reconsideration and withdrawal of the Examiner's obviousness rejection of claims 1-8 and 47-80 are respectfully requested.

Dependent claim 9 has been rejected under 35 U.S.C. § 103 as being unpatentable over Feezell in view of Kramer in further view of U.S. Patent No. 5,835,896 to Fisher et al. ("Fisher"). Applicant submits that Fisher does not teach or suggest the aspects of claim 1 not taught by Feezell in view of Kramer. Therefore, even if the combination of Feezell, Kramer, and Fisher is proper, such combination still does not teach every aspect of independent claim 1. Thus, dependent claim 9 is believed to be allowable at least by its dependency on independent claim 1. Reconsideration and withdrawal of the Examiner's rejection of claim 9 are respectfully requested.

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*Conclusion*

In view of the foregoing amendments and remarks, Applicant respectfully submits that the Examiner's rejections have been overcome, and that the application, including claims 1-9 and 47-80, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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